

Inventor : Dong
Serial No. : 10/629,261
Filed : 07/28/2003
Page : 27

REMARKS

In the instant Office Action, claims 1-16 are listed as pending and all claims are subject to restriction and/or election requirement. As per the Preliminary Amendment filed July 28, 2003, claims 17 and 18 have been cancelled without waiver or prejudice. Claims 1, 9, 15 and 16 have been amended solely in response to the restriction requirement. Claims 6 and 12-14 have been withdrawn from consideration for being directed to unelected subject matter. New claim 19, support thereof found on page 44, Example 399 as well as in original claims 15 line 29 and 16 line 22 of the specification as filed, has been added. Applicant expressly reserves the right to reclaim the subject matter surrendered in response to the restriction requirement by either reintroducing said subject matter in the present application or filing a subsequent application.

Applicant hereby requests that the Correspondence Address be changed in the instant application as per the enclosed form PTO/SB/122.

On page 2 of the instant Office Action, the Examiner notes that the computer readable form (CRF) of the sequence listing submitted with the original filing on July 28, 2003 contained 411 sequences while the paper copy submitted with the original filing contained 415 sequences. In compliance with 37 CFR § 1.821 – 1.825 and § 1.52(e), Applicant submits herewith duplicate replacement CRFs of the sequence listing, each containing 415 sequences. In accordance with 37 CFR § 1.821(f), Applicant submits that the replacement CRF sequence listings submitted herewith are identical to each other and to the paper copy submitted with the original filing. Support for SEQ ID NO:412 is found on page 2 lines 23-24, support for SEQ ID NO:413 is found on page 13 line 3, support for SEQ ID NO:414 is found on page 13 line 6, and support for SEQ ID NO:415 is found on page 15 lines 9, 11 and 16 in the specification as filed on July 28, 2003. In accordance with 37 CFR § 1.825(a), Applicant submits that no new matter is introduced in the replacement CRFs. Applicant states that a revised paper copy is not required and that the specification, as originally filed, correctly inserts the correct SEQ ID NO.s next to the appropriate peptide sequence and, as such, amendment of the specification is also not required.

On page 2 of the instant Office Action, the Examiner defines two subgenera: G1 wherein R² and R³ are both hydrogen atoms and G2 wherein at least one of R² and R³ is a substituent other

Inventor : Dong
Serial No. : 10/629,261
Filed : 07/28/2003
Page : 28

than hydrogen. The Examiner alleges at page 3 of the instant Office Action that the following groups of claims define patently-distinct inventions:

- I. Claims 1-5, 7, 8 and 11, drawn to compounds fitting the definition of G1;
- II. Claims 1-8 and 11, drawn to compounds fitting the definition of G2;
- III. Claims 12-14, drawn to methods of using the compounds of Group I; and
- IV. Claims 12-14, drawn to methods of using the compounds of Group II.

The Examiner notes that claims 9, 10, 15 and 16 are not grouped but that upon election of Group I or Group II for examination, claims 9, 10, 15 and 16 will be joined to the elected group.

The Examiner alleges that the inventions are distinct because, while inventions {I, II} and {III, IV} are related as product and process of use, the process for using the product as claimed can be practiced with another materially different product or the product as claimed can be used in a materially different process of using that product (MPEP 806.05(h)).

On page 4 of the instant Office Action, the Examiner notes that the Applicant is required under 35 USC 121 to elect a disclosed species for prosecution on the merits, to which the claims shall be restricted if no generic claim is finally allowed. The Examiner notes that should Applicant select either Group I or II, election of a fully defined compound is required. The Examiner also notes that in the event that either Group III or IV is selected, election of a fully defined compound is required as well as a specific disease or agonist effect. Regardless of election, the Examiner notes that the response must also include a listing of the claims readable thereon by the elected species, including any additional claims. The Examiner notes that upon allowance of a generic claim, the Applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as per 37 CFR 1.141. In the even that claims are added after the election, the Examiner notes that Applicant must indicate which are readable upon the elected species (MPEP 809.02(a)).

PROVISIONAL ELECTION

Inventor : Dong
Serial No. : 10/629,261
Filed : 07/28/2003
Page : 29

Applicants elect for examination of the claims of Group I, *i.e.*, claims 1-5, 7, 8 and 11, drawn to compounds fitting the definition of G1 (wherein both R² and R³ are hydrogen atoms).

Claim 1 remains as an independent claim and is amended to include the limitation that both R² and R³ are hydrogen atoms. Claims 2 and 11 remain dependent from claim 1, claim 3 remains dependent from claim 2, claim 4 remains dependent from claim 3, claim 5 remains dependent from claim 4, claim 7 remains dependent from claim 5, and claim 8 remains dependent from claim 7. Claims 9, 10, 15 and 16, while not grouped, depend from claim 1 as follows: claims 9, 11 and 15 remain dependent from claim 1, claim 10 remains dependent from claim 10 and claim 16 remains dependent from claim 15. Claim 6 is cancelled and claims 12-14 are withdrawn. Claim 19 is new. All pending claims are thus drawn to a compound in which both R² and R³ are hydrogen atoms.

Applicant elects the sequence of SEQ ID NO:55 as the species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held allowable and as the specific, fully defined compound required by the Examiner. SEQ ID NO:55 reads upon claims 1, 15, 16 and new claim 19.

This election is made without traverse.

REQUEST FOR REJOINDER

Applicant notes that method claims 12-14 are subject to rejoinder upon the allowance of product claim 1. As noted by the Examiner and in MPEP821.04:

[I]f Applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims which depend from or otherwise include all the limitations of the allowable product claim will be rejoined . . . Process claims which depend from or otherwise include all the limitations of the patentable product will be entered as a matter of right if the amendment is presented prior to final rejection or allowance."

Applicant respectfully requests that claims 12-14, which depend from claim 1 and thus include all limitations of claim 1, be rejoined with claim 1 and entered as a matter of right in the event that claim 1 is found allowable. Applicants submit that claims 12-14 currently incorporate the limitation of claim 1 by the language "administering an effective amount of a compound of claim 1."

Inventor : Dong
Serial No. : 10/629,261
Filed : 07/28/2003
Page : 30

Reconsideration of the instant Office Action, entry of the amendments submitted herewith, and allowance of all pending claims are respectfully requested. Prompt and favorable action is solicited.

CONCLUSION

Applicant submits that each ground for rejection asserted by the Examiner in the instant Office Action has been removed. On this basis, it is submitted that all pending claims as amended herein are now in a condition for allowance.

Prompt and favorable action is solicited.

Should Examiner Lukton deem that any further action be desirable with respect to these matters, he is requested to telephone the Applicant's undersigned representative.

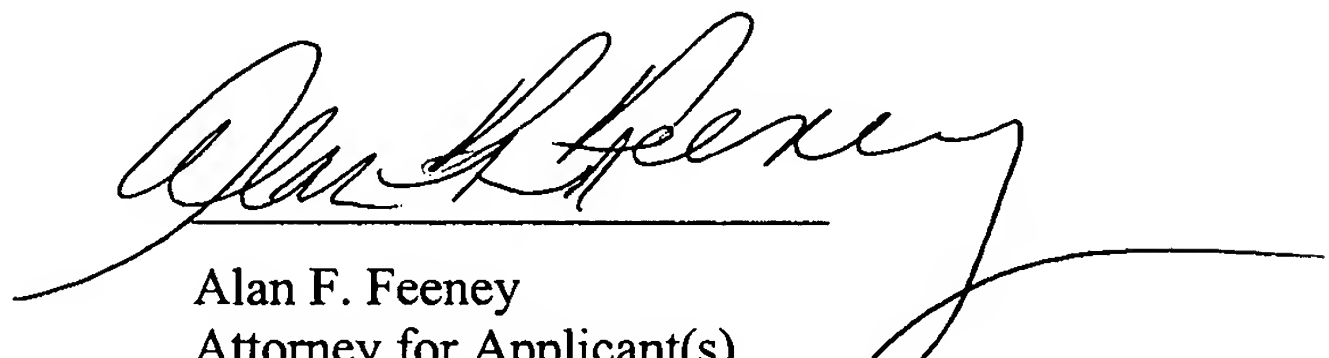
The Commissioner is hereby authorized to charge any additional fees associated with this communication or credit any overpayment to Deposit Account No. 50-0590.

Respectfully submitted,

Date:

8/1/2005

IPSEN (Biomeasure)
27 Maple Street
Milford, MA 01757-3650
(508) 478-0144 Telephone
(508) 473-3531 Facsimile


Alan F. Feeney
Attorney for Applicant(s)
Reg. No. 43,609